

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventorship Whitten et al.
Applicant Microsoft Corp.
Group Art Unit 3714
Examiner Nguyen
Attorney's Docket No. MS-158564.01
Title: "Method and Apparatus for Managing Data in a Gaming System"

REPLY BRIEF

To: Commissioner for Patents
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Pursuant to 37 C.F.R. § 41.41, Appellant hereby submits a reply brief in application No. 09/802,797, within the requisite time of the Examiner's Answer.

REMARKS

Appellant maintains the positions set forth in the Appeal Brief, and respectfully submits that pending claims 18, 20-35, 57-58, 60 and 69-71 are allowable.

Double Patenting Rejections

The Office has maintained its provisional rejections of claims 18, 20-35, 57-58, 60 and 69-71 under the doctrine of obviousness-type double patenting over claims 1-36 of U.S. Patent No. 6,716,102. Applicant requests that the Office hold these rejections in abeyance until the indication of allowable subject matter.

§ 103 Rejections

Appellant's Appeal Brief was filed prior to the Supreme Court's recent ruling in KSR International Co. v. Teleflex, Inc., No. 04-1350 (April 30, 2007). In KSR, the Court addressed the §103 standard in detail, explaining that "rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Slip Op. at 14, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The Court further emphasized that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." Slip Op. at 17, citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 36 (1966). While Appellant's Appeal Brief was drafted and filed prior to KSR, the findings in KSR simply reinforce Appellant's position.

First, the Office has failed to show that the cited references disclose or suggest all of the features recited in Appellant's claims. Second, even if the cited references did

show all of the features recited in Appellant's claims (which they do not), the Office has failed to provide "articulated reasoning with some rational underpinning" to support the cited combination of references. Accordingly, Appellant maintains that the Office has failed to establish a prima facie case of obviousness with respect to claims 18, 20-35, 57-58, 60 and 69-71 of Appellant's application.

In the Claims

The Office has maintained its rejections of claims 18, 20-25, 27-35, 57, 58, 60 and 69-71 under 35 U.S.C. §103(a) for allegedly being obvious over U.S. Patent No. 6,599,194 to Smith et al. ("Smith") in view of Microsoft®Windows98. The Office has also maintained its rejections of claims 26, 32, and 33 stand rejected under 35 U.S.C. §103(a) for allegedly being obvious over Smith in view of Microsoft®Windows98 in further view of Links 386CD Players Manual. Appellant respectfully disagrees.

In articulating the rejections of these claims, the Examiner has simply restated in the Examiner's Answer the rejections presented in the Final Office Action. Appellant addressed these rejections at length in Appellant's Appeal Brief, and in the interest of brevity, references those arguments in their entirety rather than repeat them herein. Appellant offers the following additional observations responsive to the Examiner's Answer dated 8/24/07. While these observations are made for the sake of brevity with reference to the recited language of claim 18, the Appellant considers the following arguments applicable to each of the independent claims and their respective dependent claims.

1. With reference to the discussion of KSR presented above, Appellant maintains that the Examiner has still failed to establish a *prima facie* case of obviousness at least because the proposed combination lacks all the features in the claims as presently recited.

5 In the Answer on p. 11, the Examiner asserts that portion of Microsoft®Windows98 (p.80-81) is cited to indicate that the reference pertains to “a computer with a disk drive as well as to provide teachings for the partitioning of drives”. This first part of Microsoft®Windows98 cited does discuss the difference between the FAT16 and the FAT32 file systems. While this discussion does deal with ways in which a
10 hard drive can be organized, there is no mention whatsoever of the ability for the hard disk drive to be configured to store application data such that data associated with a first application is inaccessible to other applications, as recited for example in claim 18.

In the Answer on p. 11, the Examiner asserts that Microsoft®Windows98 (p.87-90) is cited to teach “ a game console having a hard disk that is configured to store
15 application data such that data associated with a first application is inaccessible to other applications”. Respectfully, this conclusion is rooted in hindsight as it simply restates the recited features of claim 18. Further, the second part of the excerpt from Microsoft®Windows98 deals with the sharing of folders and printers attached to a user’s computer with other people on a network and not a game console, configuration of a hard
20 drive, application data, and so forth as suggested by the foregoing conclusion of the Examiner.

Thus, the portions of Microsoft®Windows98 relied upon are entirely devoid of any discussion related to application data, applications accessing data, or data associated with a first application is inaccessible to other applications. Sharing of files and folders

in a network with share level control settings is not equivalent to the recited features of claim 18. The Examiner has still failed to explain how sharing of files and folders in a network setting as in Microsoft®Windows98 is equivalent to the recited features of claim 18.

5 Rather, in the Answer on p. 11-12, the Examiner argues that a profile may be considered an application, and hence the use of profiles provides a basis for the profile accessing related files. Since there is absolutely no discussion of profiles in the reference itself, the Appellant is left to guess at the Examiner's intended meaning. Based on the rejections as a whole, the Applicant understands the Examiner as asserting that the profile
10 inherently does not access unrelated files (*See, Answer p. 5 discussing inherent features*). The Examiner appears to equate the use of a profile inherently not accessing some file to the recited features which are acknowledged as lacking from Smith, such as the recited inaccessibility feature of claim 18, "wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other
15 applications".

Applicant respectfully disagrees. Those of ordinary skill in the art would not consider a profile to be an application. Applicant rebuts the conclusions of the Examiner with respect to a profile and asserts that a common understanding of a profile is a data record having a variety of data to describe custom user settings such as display settings,
20 network settings, background images, and so on. For instance, a profile may consist of configuration settings and other data associated with an individual user or with a group and/or personal information about a user, such as for an account of the user. In a network environment, a user may access their profile from different devices which may use the data to present a familiar work environment. Thus, the use of a profile is not a basis for

the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications, as asserted by the Examiner.

Nevertheless, even assuming for the sake of argument that a profile may be construed to be an application, the Examiner has still failed to provide any citation or particular explanation of how a profile is derived from the references. Indeed, after careful review, the Applicant does not find any discussion of a profile in Microsoft®Windows98 at p. 80-81 or 87-90. The term profile is not even mentioned. Thus, even assuming the Examiner is correct in the interpretation offered for a profile, there is no support for this position from the references of record. Thus, this assertion by the Examiner amounts to the type of “mere conclusory statements” cautioned against in KSR. The Examiner’s discussion of a profile in the Answer on p. 11-12 is simply unsupported by the references or other evidence on the record.

Further, as noted the cited portion of Microsoft®Windows98 is directed at sharing of files and printers in a network environment and not configuration of a hard drive. For instance, Microsoft®Windows98 states “If you set up a Microsoft or Novell network client, you can share your documents – and any printers attached to your computer – with other people on the network”. *Microsoft®Windows98, p. 87*. Assuming for the sake of argument that a profile were involved in Microsoft®Windows98, logically the profile would be applied for the disclosed network sharing of file and printers and not to organize application data on a hard disk of a game console as asserted by the Examiner. Respectfully, the Examiner in relying upon profiles which are not discussed at all in the references and then equating the profiles to the features of claim 1 relies upon conclusory *ex post* reasoning that is not permissible, as is noted in the previous discussion of KSR.

Thus, the Examiner in making out the rejections has not met the burden of establishing a *prima facie* case of obviousness by providing rational conclusions which are supported by evidence on the record rather than mere assertions. In this case, Microsoft® Windows98 does not teach, or in any way suggest, a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The Office has acknowledged that Smith lacks these claimed aspects. Accordingly, the proposed combination of Smith and Microsoft® Windows98 lacks all of the recited features of the claims as presently recited.

2. With reference to the discussion of KSR presented above, Appellant maintains that the motivation provided by the Office for combining Smith and Microsoft® Windows98 lacks the required “rational underpinning”.

The Examiner indicates on p. 12 of the Answer that the rejection is not improper because the teaching of Microsoft® Windows98 would “prevent errors by preventing undesired alteration of certain files and folders and to maintain an organized hard disk system. At the same time, the Examiner in discussing Smith on p. 5 of the Answer asserts that “a game program inherently is only going to request files called by executable instructions and associated with the video game. Therefore inherently, the video game would not access portions of the hard disk that are not associated with the game” and “the hard disk is partitioned for different kinds of data”.

Applicant asserts that these two statements are contrary to one another and serve to further undermine the Examiner’s proposed motivation. While the Applicant does not agree with the foregoing characterization of Smith, under the Examiner’s stated reasoning, there would be no need to add the features assertedly provided by Microsoft®

Windows98. The Examiner suggests that Smith would inherently prevent unintended access to the hard disk. In the Examiner's words, inherently "the video game would not access portions of the hard disk that are not associated with the game". One is compelled to ask why, if the system of Smith inherently manages data as suggested by the Examiner, one of skill in the art would undertake combining Smith with Microsoft® Windows98 "to prevent errors by preventing undesired alteration of files" as assertedly achieved through the proposed combination.

Still further, the Examiner on p. 13 of the Answer maintains the asserted motivation of improved organization and error prevention. The Examiner states that this motivation is not too general but describes "specific ways in which the combination would improve efficiency, through improved organization and error prevention as stated in the current rejection". Respectfully, the Examiner still refrains from an attempt to enumerate these asserted "specific ways" in which the combination would improve efficiency. In particular, there is no discussion of the "specific ways" in the portion of the Answer on p. 13. Rather, the Examiner merely restates the motivational statement made in the Final Office Action dated 11/13/2006, which the Appellant addressed at length in Appellant's Appeal Brief, for example point "f" on p. 23-26.

Further, if the Examiner is correct that Smith inherently includes "the video game would not access portions of the hard disk that are not associated with the game" then combining Smith with another reference to "prevent errors by preventing undesired alteration of certain files and folders" would not increase efficiency at all. Under the reasoning provided by the Examiner, the proposed combination amounts to adding of complexity to Smith to address a non-existent problem. Thus, the proposed combination results in less and not more efficiency, which defeats the Examiner's stated basis for

motivation. Respectfully, the inconsistent reasoning provided by the Examiner cannot be said to fulfill the requirement of “articulated reasoning with some rational underpinning” as stated in KSR.

For at least the foregoing reasons, the Office has failed to make out a *prima facie* case of obviousness with respect to claim 18. As noted, the Appellant considers the foregoing arguments made with reference to claim 18 applicable to each of the independent claims and their respective dependent claims.

Accordingly for the reasons stated herein in addition to the reasons set forth in the Appellant’s Appeal Brief, claims 18, 20-25, 27-35, 57, 58, 60 and 69-71 are allowable over the proposed combination of Smith in view of Microsoft®Windows98, and claims 26, 32, and 33 are allowable over Smith in view of Microsoft®Windows98 in further view of Links 386CD Players Manual. Appellant respectfully requests that the §103 rejections be overturned and that pending claims be allowed to issue.

Conclusion

The Office's basis and supporting rationale for the rejections discussed above are not supported by the Office's arguments or the cited references. Appellant respectfully requests that the rejections be overturned and that pending claims be allowed to issue.

Respectfully submitted,

Date: 10/24/07

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